This application has been reviewed in light of the Office Action dated January 14, 2004. Claims 1-51 and 54 are pending in this application. Claims 2 and 14 have been amended only as to matters of form, and not to overcome any of the rejections discussed below. Claims 1, 17-20, 36, and 54 are in independent form. Favorable reconsideration is requested.

The Office Action rejected Claims 1-51 and 54 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully traverses these rejections. Applicant submits that the recitation "traversable physical path" as used in the claims is enabled by the specification as originally filed. For example, the specification at page 1, line 29, to page 2, line 3, describes the function of a user traversing a hyperlink by following indicia and accessing a cut out within a page; the specification at page 7, lines 18-24, describes the traversal of a hyperlink through operations of the user; the specification at page 8, lines 6-11, describes the traversing of a hyperlink through "simply moving the thumb or finger slightly to grasp the desired size of the cut out in the printed version"; the specification at page 8, line 21 *et seq.* describes a hyperlink as being typically implemented physically as cut out tabs and, through the use of a one-dimensional vector, described as "path traversed" by a hyperlink. Further, the specification uses the term "path" as relating to the various tabs and the like, one good example of which is found at page 12, lines 7-9, which describes a tab leading from page A to B as providing "an implicit return path from page B to page A". The use of the term "traversable physical path" in the claims describes that feature of the specification which represents a combination of anchors and links, printed paths (e.g., Fig. 8A, 1004, 1006, 1008) and cut-

out tabs (e.g., Fig. 8A, 1002) that permit user traversal of the document from one location to another. Applicant submits that, at least for the reasons presented above, the recitation "traversable physical path" is enabled by the specification, and therefore Applicant respectfully requests withdrawal of the rejections.

The Office Action rejected Claims 1-51 and 54 under 35 U.S.C. § 103(a) as being unpatentable over European Patent Application No. EP 0 775 962 A2 (Yoda) in view of U.S. Patent No. 5,337,161 (Hube). Applicant respectfully traverses these rejections and submits that independent Claims 1, 17-20, 36, and 54 are patentable over the cited prior art for at least the following reasons.

An aspect of the present invention set forth in Claim 1 is directed to a method of creating a document suitable for hard copy reproduction. According to the method, information from at least one electronic source document is received. The information includes a plurality of referential links establishing corresponding referential paths between components of the information. The method also defines a physical structure of the document suitable for hard copy reproduction and sufficient to reproduce the information, and defines a plurality of document links associated with the physical structure and corresponding to the referential links. The method further assigns a user interpretable functional link to each document link, with each functional link forming a traversable physical path in the document between components of the information, and arranges a number of the functional links by assigning plural ones of the document links to at least an individual one of the functional links.

Yoda, as understood by Applicant, relates to an information print

apparatus and method. In addition, Hube, as understood by Applicant, relates to tab image extraction and placement. Applicant initially notes that both Yoda and Hube primarily are concerned with page numbering and the effective linking of a table of contents to numbered pages within a document. However, there is a fundamental difference between the method of creating a document suitable for hard copy reproduction having the features recited in Claim 1, and Hube and Yoda, when taken separately or in any proper combination. In particular, with respect to page numbering, it is clear from each of Yoda and Hube, as it is also reasonable from well established printing arts, that each page of a document can only possess a single page number. Applicant acknowledges such at page 8, line 21, of the specification, which discusses a hyperlink as forming an anchor from a first page "S" to a target page "T" and is represented by a one-dimensional vector, thereby contributing to the recitation of the "traversable physical path." This section of the specification clearly distinguishes the presence of the hyperlink from the page (or page numbering), and provides a basis by which plural such hyperlinks may be formed on any one page. Examples of this is seen in Figures 8A and 8B while more illustrative examples are seen in Figure 6, where a number of cut-out tabs are provided on each page of the printed document.

The Office Action at page 4 states that Yoda discloses "(d) assigning a user interpretable functional link to each [the] document link " and that the Examiner is interpreting "user interpretable functional link" to be equivalent to generating page numbers. Applicant notes that even if Yoda is deemed to suggest that a page number can represent a link in a printed document between a table of contents and actual information, such page numbering does not, in and of itself, create a functional link between items of

information that is user traversable such as in Claim 1. Moreover, such interpretation is unsupportable where more than one functional link is provided on any one page of the printable document.

The Office Action at page 5 relies on Hube as disclosing "a traversable physical path" (col. 2, lines 13-27). Applicant submits that this section merely discusses creating tabs that incorporate tab images extracted from a table of contents. This operation in Hube is one founded merely upon user identification and placement of the image content from the table of contents onto the relevant tab associated with the particular chapter heading.

Hube discusses that the user effectively selects the tab image by placing a bounding box about the tab image using a mouse pointer (column 8, lines 47-59, and Fig. 12, steps S51-S56, and Fig. 17). This "tab image" is then set to be that portion within the selected bounding box (e.g., see reference numeral 214 in Fig. 17). Hube then proceeds to discuss an arrangement by which that piece of image data, which was selected by the user, is then appropriately placed (e.g., reference numeral 219 in Fig. 17) onto a tab at a page number upon which the relevant chapter of the document is to commence.

Hube discusses an arrangement that is significantly different from the method having the features recited in Claim 1. For example, in Claim 1, step (a) requires receiving information "from at least one electronic source document, the information including a plurality of referential links establishing corresponding reverential paths between components of the information". Applicant notes that those reverential paths are used in the method as recited in Claim 1 to result in the user interpretable functional link. In contrast, nothing has been found by Applicant in Hube that would teach or suggest such

referential links. Hube in this regard discusses an electronic reprographic printing system in which the original document is scanned electronically as a series of images (column 4, line 35). Applicant notes that such a scanned document contains no specific links comparable to the recited "referential links". Hube then discusses an arrangement by which the user then manually selects image content from the table of contents to create the image tabs that are ultimately electronically placed onto the tabs of the pages to be printed. As a consequence, Hube discusses a digital photocopier that affords a user the ability to select an image portion and to copy and paste a portion of that selected image as desired into the document. However, nothing has been found in Hube relating to any such referential links being contained within the original electronic document, nor, in Hube, is there ever an original electronic document of the type recited in the method of Claim 1.

In view of this clear distinction between Hube and the method having the features recited in Claim 1, Applicant submits that there would be no motivation by someone of ordinary skill in the art to combine the teachings of Hube with that of Yoda. Hube, for example, does not describe any hyperlinking between content of the original source document. Consequently, the image tabs of Hube have no operative interaction when in combination with the hyperlinks described in Yoda.

In the method having the features recited in Claim 1, the referential paths need not contain cut out or tabs but may be formed by printed paths on respective pages. As such, Applicant has not found anything in Yoda and Hube, when taken separately or in any proper combination, that would teach or suggest any arrangement other then the mere combination of those two documents - one where the table of contents of Yoda has links to pages (not actual information) at which corresponding information commences and second,

where those pages include tabs incorporating image information extracted by the user from the table of contents (Hube).

Applicant submits that even if the hyperlink information discussed in Yoda were used to produce the tabs in Hube, such production distorts the fact that the "functional link" of Yoda is the page number, not the tab. Tabbed pages of Hube remain numbered and there is no apparent link between those page numbers and the tab. Accordingly, Applicant submits that at least for the reasons discussed above, Claim 1 is patentable over the cited prior art, when taken separately or in any proper combination.

Applicant notes that the Office Action does not discuss why the feature of the "arranging step" as recited in Claim 1 was rejected or how either Yoda or Hube would have taught or suggested this feature. Should Claim 1 be rejected based on the recitation of the "arranging step", the Examiner is respectfully requested to make such rejection "non-final" to give Applicant the opportunity to respond.

In this regard, Applicant notes that nothing has been found in Hube or Yoda, when taken separately or in any proper combination, that would teach or suggest the "arranging step", as recited in Claim 1. Moreover, any attempt to read this feature on to Hube or Yoda fails whenever there is more than one functional link per page, this arising from the reliance upon Hube and Yoda on page numbering. Further, more importantly, nothing in Hube or Yoda has been found that would teach or suggest that any one functional link may have ascribed to it more than one document link. In Hube, this would necessitate multiple tabs on any one page. Such would not appear reasonable in view of Hube's continued mentioning of "tab stock". In this regard, Claim 1 recites "plural ones of the document links". Accordingly, those situations where only one document link is

ascribed to one functional link, is expressly disclaimed in the present application. Applicant observes that such is clearly known from the prior art (e.g., Fig. 10A of the present application).

In summary, it follows from the description above that the page numbering and tabs referred to in any reasonable combination of Yoda and Hube would not teach or suggest the arrangements as recited in independent Claims 17-20, 36, and 54. Consequently, those claims are believed to be patentable for the same reasons described above in connection to Claim 1.
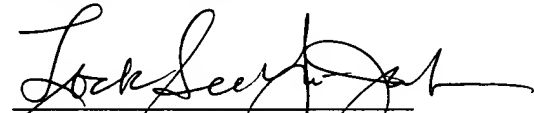
The other rejected claims in this application depend from one or another of the independent claims discussed above, and therefore are submitted to be patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

This Amendment After Final Action is believed to place this application in condition for allowance and, therefore, its entry is believed proper under 37 C.F.R. § 1.116. Accordingly, entry of this Amendment After Final Action, as an earnest effort to advance prosecution and reduce the number of issues, is respectfully requested. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and the allowance of the present application.

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,

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- 24 -